

## INDEX.

### PETITION.

	Page
Short and Summary Statement of the Matter Involved	2
Questions Presented .....	3
Question 1 .....	3
Question 2 .....	3
Reasons Relied Upon for the Allowance of a Writ of Certiorari .....	3
1. The Questions of Law Presented Depend Upon the Construction of a United States Statute, and are of Great Public Importance.....	3
2. The Questions of Law Presented Have Not Been, But Should be Decided by This Court..	4
3. The Judgment and Opinion of the United States Court of Appeals May Seriously Hinder and Confuse the Future Administration of the Patent Law .....	5

### BRIEF.

The Opinion of the Court Below .....	7
Jurisdiction .....	7
Statement of the Case .....	8
Specification of Errors .....	9
Summary of Argument .....	9
Argument .....	10
1. Section 4886 R. S. Does Not Require a Showing of Comparative Utility in Establishing that the Improved Device is Useful Within the Mean- ing of This Statute .....	10
2. This Court Has Not Ruled Upon the Question of Utility Required to Support the Granting of a Patent, but the Decision of the Court of Appeals Has Not Given Proper Effect to Ap- plicable Decisions of This and Other Courts That Have Passed Upon This Question.....	12

	Page
3. The Judgment and Opinion of the Court of Appeals May Seriously Hinder and Confuse the Future Administration of the Law by the Patent Office .....	17
4. The Decision of the Court of Appeals Would Place an Unreasonable Burden on an Applicant for a Patent and Make it Especially Difficult for the Individual of Little Means to Secure a Patent .....	21
Conclusion .....	22

## APPENDIX.

*Statutes.*

Sec. 4886 .....	23
-----------------	----

*Rules of Practice in the United States Patent Office.*

Rule 76 .....	24
---------------	----

## TABLE OF CASES.

American Steel Foundries v. Robertson, 262 U. S. 209	8
Butterworth v. Hill, 114 U. S. 128 .....	12
Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 421 .....	21
Cook & Douglas, In re, 103 F. (2d) 909, 41 USPQ 671..	18
Dismuke v. United States, 297 U. S. 167 .....	20
Eames v. Andrews, 122 U. S. 40, 65 .....	4, 14
Expanded Metal Co. v. Bradford, 214 U. S. 366.....	11
Federal Trade Commission v. American Tobacco Company, 274 U. S. 543 .....	5
Hailes v. Van Wörmer, 87 U. S. 353, 368.....	11
Hammar v. Robertson, 6 F. (2d) 460 .....	12
Hartford Empire Co. v. United States, 323 U. S. 386..	22
Hildreth v. Mastoras, 257 U. S. 27, 34.....	4, 12, 14
Holmes, In re, 63 F. (2d) 642, 643 .....	4, 17
Hoover Co., The, v. Coe, 325 U. S. 79 .....	8
Lamb Knit Goods Co. v. Lamb Glove & Mitten Co. (C. C. A. 6), 120 Fed. 267, 272 .....	15
Leeds & Catlin v. Victor Talking Machine Co., 213 U. S. 301 .....	11

# Index Continued.

iii

## Page

Loom Co. v. Higgins, 105 U. S. 580.....	11
Morgan v. Daniels, 153 U. S. 120 .....	8
Mulholland, In re, 129 F. (2d) 860, 54 USPQ 388, 393..	18
Nelson, In re, 134 F. (2d) 187, 56 USPQ 548, 553.....	19
Oberweger, In re, 115 F. (2d) 826, 47 USPQ 455, 457..	4, 15
Seymour v. Osborne, 78 U. S. 516, 548-549.....	4, 12, 13
Simplex Paper Box Corp. v. Rosenthal Paper Co., 104	
F. (2d) 349, 352 .....	14, 15
Special Equipment Co. v. Coe, 324 U. S. 370.....	8
Steinmetz v. Allen, 192 U. S. 543, 556 .....	8, 20
Tompkins-Hawley-Fuller Co. v. Holden (C. C. A. 2),	
273 F. 424, 430 .....	15
United States v. State of Minnesota, 270 U. S. 181....	20

1. ...  
2. ...  
3. ...  
4. ...  
5. ...  
6. ...  
7. ...  
8. ...  
9. ...  
10. ...  
11. ...  
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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1945.

\_\_\_\_\_  
No. \_\_\_\_\_  
\_\_\_\_\_

BENJAMIN WAITE BLANCHARD, JR., *Petitioner*,

v.

CASPER W. OOMS, Commissioner of Patents, *Respondent*.

\_\_\_\_\_  
**PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR THE  
DISTRICT OF COLUMBIA.**

\_\_\_\_\_  
*To the Honorable the Chief Justice and Associate Justices  
of the Supreme Court of the United States:*

Your petitioner, Benjamin Waite Blanchard, Jr., by his attorney, respectfully prays that a Writ of Certiorari issue to the United States Court of Appeals for the District of Columbia to review the Judgment of that Court entered in the above entitled cause on February 25, 1946, affirming the dismissal of petitioner's complaint.

A transcript of the Record, including the proceedings in the said United States Court of Appeals for the District of Columbia, is furnished herewith, in accordance with Rule 38 of this Court.

### **Short and Summary Statement of the Matter Involved.**

On April 7, 1939, your petitioner filed an application for Letters Patent of the United States in the United States Patent Office for certain improvements in Radio Antenna, which said application was designated as Serial No. 266,453.

After due proceedings had in the Patent Office, according to the Rules of Practice of the United States Patent Office, the Examiner in the Patent Office finally rejected claims 2 to 7, inclusive, in this application, for the reason that,

“The device claimed is not seen to be other than equivalent to any ordinary type of capacity plate or coil antenna”. (R. 67.)

The Examiner cited six prior patents (R. 75-83) as representative of the prior art, but he acknowledged:

“It is admitted that none show applicant's structure, though all are similar in purpose and function”. (R. 68.)

On appeal by the petitioner to the Board of Appeals in the United States Patent Office, the Examiner's decision was affirmed (R. 72).

The Board of Appeals also admitted with respect to these prior patents:

“It may be conceded that these citations do not anticipate the terms of the appealed claims”. (R. 74)

Thereafter, in accordance with the provisions of Sec. 4915 of the Revised Statutes of the United States, U. S. Code, Title 35, Sec. 63, petitioner filed his complaint (R. 1) in the United States District Court for the District of Columbia, praying that a decree be issued authorizing the Commissioner of Patents to grant a patent to petitioner as provided by Sec. 4915 R. S. The District Court entered a judgment (R. 10) dismissing the complaint.

An appeal was taken by the petitioner (R. 10) from the decision of the United States District Court for the District

of Columbia to the United States Court of Appeals for the District of Columbia, which, in a decision (R. 85) dated February 25, 1946, affirmed the judgment of the lower Court, because petitioner did not show by a "test of comparative utility" that his "device is superior to those disclosed in the prior patents".

### **Questions Presented.**

The decision of the United States Court of Appeals for the District of Columbia raises the following questions of law:

1. Do the Patent Laws of the United States require an applicant for patent to show by actual tests, in comparison with the specific devices shown in the prior patents cited by the Examiner in the Patent Office, that his "device is superior to those disclosed in the prior patents"?

2. Where the prior patented devices are not in commercial use or available, is it proper to require the device embodied in a patent application to "be subjected, at the least, to the test of comparative utility" with "those disclosed in the prior patents" as a prerequisite to the issuance of a patent?

### **Reasons Relied Upon for the Allowance of a Writ of Certiorari.**

The discretionary power of this Honorable Court is invoked upon the following grounds:

1. **The Questions of Law Presented Depend Upon the Construction of a United States Statute, and are of Great Public Importance.**

The United States Court of Appeals for the District of Columbia in denying the relief sought by the petitioner has raised a question of great importance relating to the construction of a Statute of the United States, Sec. 4886 of

the Revised Statutes (U. S. Code, Title 35, Sec. 31) (Appendix page 23), as well as the Rules of Practice of the United States Patent Office, specifically Rule 76 (Appendix page 23).

This Statute provides that a person who has made any new and useful machine, manufacture, or any new and useful improvements thereon, may "obtain a patent therefor".

Rule 76 of the Rules of Practice of the United States Patent Office provides for the filing of affidavits traversing the rejection of claims on references or other grounds.

The question potentially affects the right of every applicant for a patent to the relief provided by law from an unjust refusal of a patent in the Patent Office, by denying to him reasonable and practical means of showing that he has made an invention and is entitled to the issuance of a patent therefor.

## **2. The Questions of Law Presented Have Not Been, But Should be Decided by This Court.**

It is not found that any decision of this Court has decided the issue here raised as to what utility is required for patentability by Sec. 4886 R. S., nor whether an applicant for a patent must show tests of comparative utility between his device and the prior art references.

The decision below appears to be inconsistent with the judgment of this Court in many prior cases where no showing of comparative utility was required, as in *Eames v. Andrews*, 122 U. S. 40, 65. This Court has stated that little showing of utility will satisfy the Statute. *Seymour v. Osborne*, 78 U. S. 516, 548-549; *Hildreth v. Mastoras*, 257 U. S. 27, 34.

It is inconsistent with decisions of the United States Court of Customs and Patent Appeals, which has jurisdiction over direct appeal from the Patent Office under Sec. 4911 R. S. (U. S. Code, Title 35, Sec. 59a). *In re Holmes*, 63 F. (2d) 642, 643; *In re Oberweiger*, 115 F. (2d) 826.



**3. The Judgment and Opinion of the United States Court of Appeals May Seriously Hinder and Confuse the Future Administration of the Patent Law.**

This reason is believed alone to be adequate to support the granting of the petition. *Federal Trade Commission v. American Tobacco Company*, 274 U. S. 543.

Under Rule 76 of the United States Patent Office an applicant has been permitted heretofore to file affidavits showing the improved and useful character of his invention as compared with the prior art, but has not been required to build, for comparative tests, the often complicated structures shown in the reference patents that may be cited by the Examiner against his application. The Judgment and Opinion of the Court of Appeals "that the applicant's device be subjected, at the least, to the test of comparative utility" would require him to do that. This would make it impossible for the individual of modest means to meet the tests of comparative utility.

Such a requirement would place a premium on great laboratories of invention and would lead to the granting of patents only to patent-holding corporations who are engaged in research and have the facilities for making the comparative tests required by the decision of the Court of Appeals. Such a reward to inventing laboratories, at the expense of the individual, should not be favored by this Court.

The Patent Office does not ordinarily require a test of comparative utility, whereby the requirement of the Court of Appeals would illegally discriminate against petitioner here, in violation of Article IV, Section 2(1) of the Constitution.

WHEREFORE, your petitioner prays that a Writ of Certiorari be issued out of and under the seal of this Court, directed to the United States Court of Appeals for the District of Columbia, commanding the said Court to certify and send to this Court on a day designated, a full and complete transcript of the Record and of all proceedings in the

Court of Appeals had in this cause, to the end that this case may be reviewed and determined by this Court; that the judgment of the said Court of Appeals be reversed; and that petitioner be granted such other and further relief as may be deemed proper.

BENJAMIN WAITE BLANCHARD, JR.,  
*Petitioner.*

By J. PRESTON SWECKER,  
*Attorney for Petitioner.*

Washington, D. C.,  
May 23, 1946.

I HEREBY CERTIFY that I have read the foregoing petition for a Writ of Certiorari, and that in my opinion it is well founded and presents grounds whereon the prayer ought to be granted, and I further CERTIFY that it is not intended for purpose of delay.

J. PRESTON SWECKER,  
*Attorney for Petitioner.*

IN THE

**Supreme Court of the United States**

OCTOBER TERM, 1945.

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No. 

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BENJAMIN WAITE BLANCHARD, JR., *Petitioner*,

v.

CASPER W. OOMS, Commissioner of Patents, *Respondent*.

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**BRIEF IN SUPPORT OF PETITION FOR WRIT OF  
CERTIORARI.**

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**The Opinion of the Court Below.**

The Opinion of the United States Court of Appeals for the District of Columbia is reported at 80 App. D. C. —; 153 F. (2d) 651; 68 USPQ 314, and appears in the Record filed herewith (R. 85).

The District Court did not file a written opinion but its findings of fact and conclusions of law appear in the Record (R. 8-9).

**Jurisdiction.**

The grounds on which the jurisdiction of this Court is invoked are as follows:

1. The Statute under which jurisdiction is invoked is Sec. 240(a) of the Judicial Code, U. S. Code, Title 28, Sec. 347.

2. The judgment of the United States Court of Appeals for the District of Columbia was entered on February 25, 1946.

3. The foregoing judgment was entered on appeal from a judgment of the United States District Court for the District of Columbia in a suit brought under Sec. 4915, Revised Statutes, U. S. Code Title 35, Sec. 63, to have remedy for the refusal of the Commissioner of Patents to grant a patent to petitioner on his application, Ser. No. 266,453.

4. Some of the previous decisions of this Court which are believed to sustain jurisdiction in this case are:

*Morgan v. Daniels*, 153 U. S. 120.

*Steinmetz v. Allen*, 192 U. S. 543.

*American Steel Foundries v. Robertson*, 262 U. S. 209.

*Special Equipment Co. v. Coe*, 324 U. S. 370.

*The Hoover Company v. Coe*, 325 U. S. 79.

#### **Statement of the Case.**

The proceedings in the Patent Office are set forth in the Petition. The application was filed on April 7, 1939.

The patent application sets forth (R. 39) that the radio antenna which constitutes the subject-matter of petitioner's invention avoids numerous objections long encountered in radio antennae as used heretofore, as well as to enable it to be constructed of compact portable character, which will have improved wave reception, even though placed in a cabinet of a radio receiving set or at another point adjacent thereto, indoors.

Thus it eliminated the necessity for the location of the antenna at a high point on top of a building and strung out at great length, as had been thought necessary heretofore. Nevertheless, it has great sensitivity, enabling the reception of foreign broadcasts readily and clearly with a wide range of all-wave reception, and is non-directional so that it need not be turned in a particular relation to the source of the radio waves as was necessary with the loop antenna in use previously.

These results are accomplished by a new arrangement of certain particular wire windings, which may include also wire mesh screens, as shown in the drawing attached to the application (R. 37).

The merits of this invention are attested not only by the affidavits in the Record (R. 44-63) (hereinafter referred to more in detail), but also by the demonstration made by petitioner in the District Court as described in the Record (R. 17). Thus, petitioner was able to obtain reception with an ordinary receiving set, in the daytime, when foreign reception is most difficult, not only of local and domestic radio stations, but also of many foreign countries.

### **Specification of Errors.**

The errors which the petitioner will urge, if the Writ of Certiorari is issued, are that the Court of Appeals for the District of Columbia erred:

1. In affirming the dismissal of Petitioner's Complaint, and upon the ground that petitioner had failed to show by a comparative test of utility improvement over the prior patents cited.

2. In holding that a comparison of this invention with the prior art available and in use is not a showing of sufficient utility and result, to justify the issuance of a patent for a novel construction.

3. In holding that petitioner has not made a sufficient showing that he is entitled to a patent for his improvement in radio antennae.

### **Summary of Argument.**

1. Section 4886 R. S. does not require a showing of comparative utility in establishing that the improved device is useful within the meaning of this Statute.

2. This Court has not ruled upon the question of utility required to support the granting of a patent, but the deci-

sion of the Court of Appeals has not given proper effect to applicable decisions of this and of other Courts that have passed upon this question.

3. The judgment and opinion of the Court of Appeals may seriously hinder and confuse the future administration of the law by the Patent Office.

4. The decision of the Court of Appeals would place an unreasonable burden on an applicant for a patent and make it especially difficult for the individual of little means to secure a patent.

### **ARGUMENT.**

#### **1. Section 4886 R. S. Does Not Require a Showing of Comparative Utility in Establishing That the Improved Device is Useful Within the Meaning of This Statute.**

There is no holding either by the Court below or by the Patent Office that the patents cited by the Examiner (R. 75-80) anticipate this invention nor suggest the combination of elements constituting this invention. In fact the Examiner admitted—

“It is admitted that none show applicant’s structure, although all are similar in purpose and function”. (R. 68)

Similarly, the Board of Appeals in the Patent Office stated:

“It may be conceded that these citations do not anticipate the terms of the appealed claims”. (R. 74)

Neither the District Court nor the Court of Appeals went further than to state generally that the prior patents show various screens and wire windings, and the Court of Appeals admitted—

“Viewing the appellant’s device in the light of these prior patents it seems clear that his antenna is comprised of previously patented features. It appears to

be true, however, that the nested windings, the bars forming a grid and wire mesh screens are arranged together in a fashion which is not shown in any of the prior patents." (R. 86)

It has long been recognized in the decisions of this Court that a new combination of known devices is patentable, though all the constituents of the combination were well-known and in common use before the combination was made. *Loom Co. v. Higgins*, 105 U. S. 580; *Leeds & Catlin v. Victor Talking Machine Co.*, 213 U. S. 301; *Expanded Metal Co. v. Bradford*, 214 U. S. 366.

In *Hailes v. Van Wormer*, 87 U. S. 353, 368, the Court stated:

"It must be conceded that a new combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made."

Notwithstanding these decisions, however, the Court of Appeals held that this invention is not patentable merely because it found that the elements used by petitioner in his invention were respectively old, although used in a new manner and in a new construction.

The new and useful results which petitioner proved that this invention accomplishes, were not even claimed by the patentees of the prior cited patents.

**The Court of Appeals did not find that the old elements as shown in the prior patents were used to accomplish the results of this invention.** There is no showing whatever that even the patentees of those prior art devices claimed for them in their patents any results comparable with the results claimed and demonstrated for this invention.

Nevertheless, the Court of Appeals held that the burden is on the applicant to prove, by a test of comparative utility between his invention and the prior patented devices, a superior result or utility before he shall be entitled to a patent for his invention. This was the only ground upon which



the Court of Appeals held that the claims are unpatentable. It is not required by the Statute or the Rules, and is erroneous in principle.

**2. This Court Has Not Ruled Upon the Question of Utility Required to Support the Granting of a Patent, but the Decision of the Court of Appeals Has Not Given Proper Effect to Applicable Decisions of This and Other Courts That Have Passed Upon This Question.**

No decision by this Court directly deciding the issues raised by the decision of the Court of Appeals has been found. Decisions by this Court which are applicable and with which the decision of the Court of Appeals is believed to be inconsistent are *Seymour v. Osborne*, 78 U. S. 516; and *Hildreth v. Mastoras*, 257 U. S. 27.

Under the present practice the Commissioner of Patents cannot be sued outside of the District of Columbia without his consent. *Butterworth v. Hill*, 114 U. S. 128; *Hammar v. Robertson*, 6 F. (2d) 460. Direct appeals from the Patent Office to the United States Court of Customs and Patent Appeals under Sec. 4911 R. S. (U. S. Code, Title 35, Sec. 59(a)) are heard also in the District of Columbia. A similar question may arise before this Court, as hereinafter pointed out. This Court sits in the District of Columbia in deciding direct appeals from the Patent Office.

Therefore it is unlikely that the precise question ruled upon by the Court below will arise in a jurisdiction other than the District of Columbia; wherefore, this Court should take the case under consideration by the issuance of a Writ of Certiorari to the United States Court of Appeals for the District of Columbia.

The need for a ruling upon this question is made more apparent by the fact that the ruling of the Court of Appeals is inconsistent with the decisions of the United States Court of Customs and Patent Appeals, as hereinafter pointed out.

This Court stated in *Seymour v. Osborne*, 78 U. S. 516, 549:



"Improvements for which a patent may be granted must be new and useful, within the meaning of the patent law, or the patent will be void, but the requirement of the patent act in that respect is satisfied if the combination is new and the machine is capable of being beneficially used for the purpose for which it was designed, as the law does not require that it should be of such general utility as to supersede all other inventions in practice to accomplish the same object. \* \* \*"

The Statute states merely that the machine or manufacture shall be new and useful to justify the granting of a patent therefor, but there was no suggestion in these decisions of the necessity for comparative tests as between the patented machine and the prior art patents. As a matter of fact, the Court indicates by its decision that it is sufficient to support the claim to patentability if the device shall perform the results claimed for it. The Court emphasized that it should not be insisted that its utility must be superior to "all other inventions in practice to accomplish the same object".

Nevertheless, the Court of Appeals here has required an applicant for a patent to show not only that his device will accomplish the results claimed for it, as has been proven beyond doubt or question, but the minimum requirement of the Court of Appeals is that he prove by a test of comparative utility that his device is an improvement over all of the prior patents and produces unusual and superior results in comparison with these prior patents, contrary to the assertion of this Court in the decision mentioned.

The decision of the Court of Appeals attempts to distinguish this case of *Seymour v. Osborne*, by asserting that it appears to be limited to a situation "where the applicant is otherwise entitled to a patent" (R. 87). Nevertheless, that is the only ground relied upon by the Court of Appeals in refusing petitioner a patent—that he has not proven by a test of comparative utility that his device is superior in result to the prior art patents cited by the Examiner. The decision leaves no doubt but that if applicant had proven

such a comparative test and shown the superiority of his device, he would have been entitled to a patent, according to the finding of the Court of Appeals. Obviously, petitioner "is otherwise entitled to a patent". Therefore, the decision is indistinguishable in the manner suggested.

This Court has repeatedly considered patents as compared with prior art patents and publications, and has not hesitated to decide questions of validity without regard to whether or not there was any proof of a test of comparative utility. For instance, in *Eames v. Andrews*, 122 U. S. 40, 65, the Court discussed extensively the relation of prior publications to the patent in suit, but finding that they did not anticipate the subject-matter of the patent, did not require a test of comparative utility for that purpose.

In *Hildreth v. Mastoras*, 257 U. S. 27, 34, the Court stated further:

"The machine patented may be imperfect in its operation; but if it embodies the generic principle, and works, that is, if it actually and mechanically performs, though only in a crude way, the important function by which it makes the substantial change claimed for it in the art, it is enough."

Other Courts have followed the same rule. In fact there appears to be no authority to the contrary. The decision relied upon by the Court of Appeals, *Simplex Paper Box Corp. v. Rosenthal Paper Co.*, 104 F. (2d) 349, 352, held that the patents were invalid because no new or useful results were shown, but there is no suggestion there that this would require a test of comparative utility between the patented devices and the prior art patents to sustain such a showing.

While exactly the same situation presented here does not arise in a patent infringement suit, as there involved, this portion of the Statute has been considered repeatedly by the Circuit Courts of Appeals that pass on questions of patentability and validity, that are ancillary to infringement. Such decisions generally are inconsistent with the view taken by the Court of Appeals for the District of Columbia in this case, in the interpretation of the Statute.

In *Lamb Knit Goods Co. v. Lamb Glove & Mitten Co.*, (C. C. A. 6), 120 Fed. 267, 272, this same Statute was under consideration, and with respect to the question of utility, the Court stated:

"It may be more or less useful than other gloves. That is unimportant. If it is a useful article, and is new, it is the proper subject of a patent, provided it involved invention to produce it. *Gibbs v. Hoefner* (C. C.) 19 Fed. 323; *La Rue v. Electric Co.* (C. C.) 31 Fed. 82; *Seymour v. Osborne*, 11 Wall. 516, 549, 20 L. Ed. 33."

Similarly, the Court held in *Tompkins-Hawley-Fuller Co. v. Holden*, (C. C. A. 2), 273 F. 424, 430:

"The courts hold that it is not essential to patentability that an invention should be the best of its kind. *Lamb Knit Goods Co. v. Lamb Glove, etc., Co.*, 120 Fed. 267, 56 C. C. A. 547; *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72; *Wheeler v. Clipper Mower, etc., Co.*, 10 Blatchf. 181, Fed. Cas. No. 17,493."

In *In re Oberweger*, 115 F. (2d) 826, 47 USPQ 455, 457, the Court stated:

"It has been held that a small degree of utility is sufficient to support a patent. *Lamb Knit Goods Co. v. Lamb Glove & Mitten Co. et al.*, 120 F. 267. See also *In re Holmes*, 20 C. C. P. A. (Patents) 902, 63 F. (2d) 644."

The only authority relied upon by the Court of Appeals here was the decision in *Simplex Paper Box Corp. v. Rosenthal Paper Co.*, which contains the general statement:

"The three patents depend for their validity upon a finding that the combination of elements old in the art operates to produce new and useful results never before attained. This fact has not been demonstrated."

A careful study of that decision reveals, however, that the Court found both the general combination and the indi-

vidual elements old, and moreover, that the results claimed for the patent were also old in the art.

This is in marked contrast with the present case where it was conceded by the Patent Office that the combination is new, the structure novel, and there is no finding or holding that the available prior art, or the patented devices, would accomplish the results of this invention. Moreover, no one of the patents, which the Court of Appeals states should be subjected to this comparative test, states that it is intended for a similar function or result. These patents, themselves, should be the best evidence of what they will accomplish.

Therefore, the weight of authority is definitely to the effect that even in an infringement suit when a test of comparative utility is more reasonably required, nevertheless the Courts do not insist upon that, but it is sufficient if the device is useful and is a new invention. It is not found that any prior decision has denied patentability, as did the Court of Appeals here, merely because of the failure to show by comparative test that "appellant's device is superior to those disclosed in the prior patents".

It will be noted significantly here, as hereinafter pointed out more in detail, that the Court does not question the sufficiency of the showing of comparative utility and improvement over the available prior art devices now in use and on the market. An unusual showing in that respect has been made by the affidavits of fifteen persons (R. 44-63) and by testimony in the District Court (R. 11-35). The only failure of proof relied upon by the Court of Appeals was the lack of a test of comparative utility with the devices shown in the prior patents themselves. Nevertheless, those devices are not available in the trade and are not in public use so far as shown.

**3. The Judgment and Opinion of the Court of Appeals May Seriously Hinder and Confuse the Future Administration of the Law by the Patent Office.**

The Patent Office is governed in its decisions and practice by decisions of the United States Court of Customs and Patent Appeals, inasmuch as the latter Court has direct appellate jurisdiction over appeals from Patent Office decisions under Sec. 4911 R. S. (U. S. Code Title 35, Sec. 59(a)).

It is not found that either the Court of Customs and Patent Appeals or the Board of Appeals in the Patent Office has held heretofore, as did the Court of Appeals in this case, that an applicant for a patent must show by a test of comparative utility that his device is superior in operation and effect to the devices shown in prior cited patents. Nevertheless, repeatedly it is stated in the decisions that it is immaterial whether the invention claimed is of greater utility than those devices.

In *In re Holmes*, 63 F. (2d) 642, 643, 16 USPQ 399, 400, the Court of Customs and Patent Appeals passed on this very question and stated:

“\* \* \* if an invention be useful in itself, it is immaterial upon the question of patentability whether the invention be of greater or less usefulness than like devices or products shown in the prior art.”

The Court of Appeals attempts to distinguish the *Holmes* case from the present situation by asserting that the patent was denied there because of lack of utility in the patentability sense. The decision makes clear, however, that the patent was denied merely because there was no advantage claimed for the change made by the applicant over the prior art reference. That is not the case here where the prior art references do not even claim, themselves, that they will accomplish the results of this invention, namely, long range, non-directional, radio reception by an inside radio antenna.

In the *Holmes* case the Court emphasized that no showing of improvement had been made for the invention claimed in the patent application. That Court has never, as far as has been found in the cited cases, required an applicant to show by a test of comparative utility the superiority of his device over the prior patents cited, even though those patented devices were not in commercial use nor available for comparative test. This Court has repeatedly accepted affidavits attesting the improvement made by the invention over the known or available prior art, as far as that which is in use is concerned, without requiring the building and testing of patented devices not available in the trade, as would be required by the decision of the Court of Appeals.

In *In re Cook & Douglas*, 103 F. (2d) 909, 41 USPQ 671, the Court accepted a showing by affidavit of the advantages of the invention claimed as compared with numerous publications and prior patents that had been cited, without requiring that those prior cited devices be tested in comparison therewith.

Similarly in *In re Mulholland*, 129 F. (2d) 860, 54 USPQ 388, 393, the Court considered a showing by affidavit alone and stated:

"We have examined the affidavit. It shows that highly successful results were obtained by 'utilizing the mechanism and coolant chambers disclosed in the above-entitled (instant) application' in polishing the surface of the glass; that this was a new procedure in the art; and that the grinding was accomplished successfully without any fracture of the glass, which is a non-conductor of heat.

"While the affidavit is not controlling, it certainly is some evidence of the increased cooling effectiveness of appellant's device. If the device will perform what the affidavit says it will on glass, which heats and cracks easily, it is reasonable to assume that it will serve a useful purpose, not known to the prior art."

There the prior art devices were large, complex glass machines that would have required many thousands of dol-



lars to have built for comparative tests if that were required but, it is evident from the decision of the Court that it was not done and not required to sustain the patentability of the claims then under consideration and held patentable by the Court on the basis of the affidavit.

This showing by affidavit is of great importance and cannot be lightly disregarded by the Patent Office, since it is in accord with Patent Office rules, as stated by the Court in *In re Nelson*, 134 F. (2d) 187, 56 USPQ 548, 553:

"In view of the fact that the prior art cited does not disclose or suggest the process defined in claim 20, and as that portion of appellant's affidavit hereinbefore set forth was not referred to by either of the tribunals of the Patent Office, we are unable to hold, on the record presented, that that claim was properly rejected."

Consistent with these decisions and Patent Office Rule 76 (Appendix p. 23), petitioner filed in the Patent Office the affidavits of fifteen persons who attested to the improved characteristics of this antenna as compared with the best known antennae then in use, and universally acclaimed the superiority of this invention for clearness of reception, long range reception, and non-directional characteristics even though the antenna be built-in or located indoors, as distinguished from long outside antenna.

Included in these affidavits was one of Roger W. Barrington, a radio engineer of wide experience and entirely unbiased, who stated with respect to petitioner's antenna tested in comparison with the best known available antenna:

"\* \* \* that in every instance the use of said antenna effected a great improvement in signal strength over the widely used loop type antenna, that in most cases there was an increase in strength over that of a normal sixty foot outside aerial, and that in all tests a definite improvement in quality of reception was effected, general fading being reduced and selective fading being eliminated; that deponent's aerial is 135 feet long

from the receiver to the far end, the highest point being 65 feet in height; that with the said Blanchard antenna deponent was able to clearly hear stations that he had never before heard, including stations that deponent had previously considered as being impossible to contact, and which were held for hours on end at will; \* \* \* (R. 57).

The Patent Office has customarily accepted affidavits of the character here supplied in accordance with Patent Office Rule 76, attesting to the superiority of the device set forth in the application as compared with known or available devices in the prior art. The rule provides for the filing of affidavits traversing cited references as customarily filed. If the decision of the Court should prevail and be binding upon the Patent Office, that the minimum requirement for patentability shall include a test of comparative utility, that the applicant's device "is superior to those disclosed in the prior patents", a change in Rule 76 will be required to provide for the acceptance of affidavits only which show such a test of comparative utility. Obviously, there would be no need of filing affidavits if they are not to be accepted as constituting a sufficient showing to overcome the references.

The Rules of Practice in the United States Patent Office represent the Commissioner's interpretation of the Statute. The Commissioner is the administrative officer of the Patent Office charged with the duty of administering the law, whereby his interpretations as indicated by the Rules are entitled to great weight, and being of long standing, are not lightly to be overturned. *Dismuke v. United States*, 297 U. S. 167; *United States v. State of Minnesota*, 270 U. S. 181. Moreover the Rules of the Patent Office comprise an authority under the law comparable with a statute. *Steinmetz v. Allen*, 192 U. S. 543, 556.

This ruling by the Court of Appeals would require a modification of the Patent Office Rule and a modification of the practice in the Patent Office if it should prevail, since it is inconsistent with the practice under which the Patent



Office operates, governed directly by the decisions of the Court of Customs and Patent Appeals.

Inasmuch as appeals from the Patent Office are taken concurrently either to the Court of Customs and Patent Appeals under Sec. 4911 R. S. or to the District Court of the United States in the District of Columbia, under Sec. 4915 R. S., it is important that this question be determined to decide which of the decisions is correct under the patent laws.

**4. The Decision of the Court of Appeals Would Place an Unreasonable Burden on an Applicant for a Patent and Make It Especially Difficult for the Individual of Little Means to Secure a Patent.**

If an applicant is required to show at the least by a test of comparative utility that his "device is superior to those disclosed in the prior patents" as required by the decision of the Court of Appeals below, this would place a premium on great laboratories of invention that have the facilities for building and testing these prior art patents, at the expense of the individual without great means at his disposal.

Here the Patent Office has cited six prior patents on radio antennae. No one of these prior patents even represents that it will accomplish the results of this invention. They are cited merely because they show wire windings, and yet these windings are not comparable in structure or effect with that which is claimed here, as evidenced by the affidavits of fifteen persons, including radio engineers, who have tested this device in comparison with the best radio antennae now in use or in the trade.

*Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 421:

"This defense presents the common instance of a patent which attracted no attention, and was commercially a failure, being set up as an anticipation of a subsequent patent, which has proved a success, because there appears to be in the mechanism described

a possibility of its having been, with some alterations, adaptable to the process thereafter discovered."

The view expressed by the Court of Appeals would place too great a burden on the individual of little means, so that in many fields it would be virtually impossible for him to secure any patent. For instance, patents in glass machinery that would require huge expenditures for test purposes, could be secured only by inventing laboratories that had the facilities for such purposes. (Cf. *Hartford Empire Co. v. United States*, 323 U. S. 386). This would cause a tremendous change in the economy of the United States, whose patent system has permitted individuals, even of little means, to profit from their developments through the protection of the patent laws. Such protection would be denied to them by the rule of the Court of Appeals if it should be allowed to stand.

This alone is a sufficient reason for this Court to accept jurisdiction and consider this case by the issuance of a Writ of Certiorari to the Court of Appeals for the District of Columbia.

### CONCLUSION.

For the foregoing reasons it is believed that this Court should be moved to grant the Writ of Certiorari, to the end that the fundamental questions of patent law here involved may be settled by this Court, and the judgment of the Court below reversed.

Respectfully submitted,

J. PRESTON SWECKER,  
*Attorney for Petitioner.*

Washington, D. C.,  
May 23, 1946.

**APPENDIX****STATUTES:**

Sec. 4886. R. S. (U. S. C., title 35, sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (The period is *two years* instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939, *infra*.)

Act of Aug. 5, 1939, 53 Stat. 1212:

Sec. 2. This Act (amending sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 62, 69, and 73) by changing "two years" to *one year*) shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: *Provided, however,* That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

**RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE:**

76. When an application is rejected on reference to an expired or unexpired domestic patent which shows or de-

scribes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the office, set forth in an affidavit (when requested) of such employee (rule 66), or when rejected on the ground of public use or sale, or upon a mode or capability of operation attributed to a reference or because the alleged invention is held to be inoperative or frivolous or injurious to public health or morals, affidavits or depositions supporting or traversing these references or objections may be received, but affidavits will not be received in other cases without special permission of the Commissioner. (See rule 138.)